



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SEP 10 2004

GUILFORD PHARMACEUTICALS CO.
FOLEY & LARDNER
3000 K STREET, NW
WASHINGTON, DC 20007-5143

In re Application of :
Barbara S. Slusher et al :
Serial No.: 09/866,961 : PETITION DECISION
Filed: May 30, 2001 :
Attorney Docket No.: 264/239 :

This is in response to the petition under 37 CFR 1.181, filed July 19, 2004, requesting withdrawal of the Final Office action.

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on February 14, 2003. Applicants replied to this Office action on May 12, 2003, canceling claims 1-24 and 27-49, amending claim 25 and presenting new claims 50-58 and responding to the outstanding rejections. The examiner mailed a new non-Final Office action to applicants on September 16, 2003, setting forth a new rejection of the pending claims. Applicants (contrary to the petition assertion) replied to this Office action on October 17, 2003. (Copy enclosed) The response of October 17, 2003, is identical to the reply made May 12, 2003. A further response was made December 16, 2003, which specifically refers to the September 16, 2003, Office action. The examiner then mailed a Final Office action to applicants on January 29, 2004, maintaining the rejection of the Office action of September 16, 2003. Applicants filed an amendment in response to the Final Office action on April 8, 2004. The amendment (argument only) makes no request to withdraw the finality of the Final Office action. The examiner mailed an Advisory Action to applicants on July 7, 2004, indicating entry of the amendment, but failure to overcome the rejection of record. Applicants also initiated a telephone interview with the examiner's supervisor (see interview summary mailed August 9, 2004) seeking withdrawal of the Final Office action and Advisory Action. This petition was filed prior to the interview.

As seen from the above chronology of Office actions and responses, conduct of prosecution was proper and the finality of the last Office action was proper. Applicants claim that no response was filed on October 17, 2003. However the application file record shows a response being filed on that date which was initially accepted as a response to the Office action of September 16, 2003. The later response of December 16, 2003, was a more proper reply to the Office action. Had no response been filed the application would have become abandoned on March 17, 2004. However, as can be seen from the record responses were made which required the examiner to reexamine the application and issue a new, in this case Final, Office action. In view of the

above, no good or sufficient reason has been given for withdrawal of the finality of the Office action mailed January 29, 2004.

Further, a request to withdraw an improper Office action by an examiner under 37 CFR 1.181 must be filed within two months of the action complained of (37 CFR 1.181(f)). Such appears not to be the case here. The request to have the Final Office action withdrawn was not made in the response filed April 8, 2004, as it should have been, but appears to have first been filed six months after the actions was taken in this petition and can therefore also be dismissed as untimely.

The petition is **DENIED**. The supervisor's indication that the Office action of January 29, 2004, is withdrawn was improper and not based on a complete understanding of the record and is vacated. Further, as a consequence of failure to properly reply to a Final Office action this application stands abandoned. A Notice of Abandonment will be forthcoming.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number.

A handwritten signature in black ink, appearing to read "BM Kisliuk", with a stylized flourish at the end.

Bruce M. Kisliuk
Director, Technology Center 1600